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81528538	\I Washi	ngton, D.C. 20231
SERIAL NUMBER FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/528.538 09/14/9	95 KANEKO	N 35.61548
		EXAMINER
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FITZPATRICK CELLA HA	MMC1/0926 ARPER & SCINTO	ARTUNEO PAPER NUMBER
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NEW YORK NY 10112		0044
	•	2841
This is a communication from the examiner in		DATE MAILED: 09/26/00
COMMISSIONER OF PATENTS AND TRADE	charge of your application. MARKS	
This application has been examined	1	Andre of
The state of the s	Responsive to communication filed on	720/00 This action is made fina
A shortened statutory period for response to the	is action is set to expire month(s);	days from the date of this letter
	amend the abbreation to pecoule aparition	ed. 35 U.S.C. 133
Part I THE FOLLOWING ATTACHMENT(S)	ARE PART OF THIS ACTION:	
1. Knotice of References Cited by Exam	niner DTO see	
3. Notice of Art Cited by Applicant, PTC	Principal Control of the Control of	e of Draftsman's Patent Drawing Review, PTO-948
5. Information on How to Effect Drawin	g Changes, PTO-1474.	e of Informal Patent Application, PTO-152.
Part II SUMMARY OF ACTION		
1. Claims	1-3, 22,23	are pending in the application.
Of the above, claims		
		are withdrawn from consideration.
2. Claims		have been cancelled.
3. Claims		
. 🖼		are allowed.
4. Claims	1-3, 22,23	are rejected.
5. Claims		oro objectada.
6. Claims		are objected to.
- []	аге	subject to restriction or election requirement.
Inis application has been filed with infor	mal drawings under 37 C.F.R. 1.85 which are ac	ceptable for examination purposes.
8. Formal drawings are required in respons	se to this Office action.	
p-rang .		
are □ acceptable; □ not acceptable (se	ve been received on ee explanation or Notice of Draftsman's Patent I	Under 37 C.F.R. 1.84 these drawings Drawing Review PTO-948).

accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

__. has (have) been approved by the

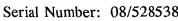
13. Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in

Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received been received been filled in parent application, serial no. ______; filled on ______;

10. The proposed additional or substitute sheet(s) of drawings, filed on ____

examiner; I disapproved by the examiner (see explanation).

14. Other



Art Unit: 2841

DETAILED ACTION

Treatment of Claims Based on Prior Art

- 1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 2. Claims 23, 2-3 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yurek et al. (US 5545613, hereafter referred to as Yurek) and Shi et al. (Swagged Superconducting Wires, hereafter Shi) and Paranthaman et al. (Formation of Anisotropic Tl-1212, Tl-2212, Tl-1223 and Tl-2223 Particles using Aerosol Flow Reacted Powders, hereafter Paranthaman).

Yurek discloses a wire of a superconductive material where the grains of the material are compact and adhered together (sintered and compact) with silver (claim 2) filling the voids of the superconductive material in Example 7 prepared with the oxide-metal composite of Example 2, placed in the inside of a metal tube (conductive material) and composing a wire, column 3 at lines 12-23, 63-67 and column 4 at lines 1-3.

Yurek discloses the claimed invention except the composition of the conductive material, thereby the higher melting point of the conductive material. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to make the conductive material of the Yurek wire copper, gold or aluminum (claim 3), or an alloy thereof (claim 22), because it is well known in the superconducting arts to make the outer sheath of wires from these metals and their



Serial Number: 08/528538

Art Unit: 2841

alloys, as evinced by Shi and Paranthaman. Selecting the conductive material as such necessarily makes the melting point of the conductive material higher than the solidified metallic material, silver (claim 23).

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yurek, as applied to claim 23 above, and Den et al. (US 5,512,538, hereafter referred to as Den).

Yurek discloses the claimed invention except for the superconducting oxide being Ln-Sr-Cu-M-O. Yurek does state that the invention is applicable to any superconducting oxide, column 2 at lines 43-44. Den discloses this type of superconducting oxide, reference the abstract.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the superconductive oxide of Den to provide the superconductive material of Yurek, because this type of superconducting oxide is one of many oxides known in the art for making superconductive wires.

Response to Arguments

4. Applicant's argument has been carefully reviewed, but is not persuasive. Applicant alleges that the rejection is improper because a reference stating that use of copper, gold or aluminum as an outer tube is well known. Applicant challenges the commonness of gold, copper or aluminum as an outer tube, because a reference is not provided. First, applicant errs in asserting that the rejection is improper; a rejection based on common knowledge is proper even if a reference is not provided. Second, in challenging what examiner considers well know, applicant has not provided adequate information to raise reasonable doubt, on its face, regarding examiner's position. Applicant merely



Serial Number: 08/528538

Art Unit: 2841

objects to the position without giving any reason. Third, in compliance with applicant's request, examiner has cited a couple of references in support of her position. As can be clearly seen, the knowledge is old in the art.

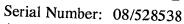
5. MPEP 2144.03 states:

If the examiner adds a reference to the rejection in the next action after applicant's rebuttal, the newly cited reference, if it is added merely as evidence of the prior well known statement, does not result in a new issue and thus the action can potentially be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the rejection is made final.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.





Art Unit: 2841

Closing

6. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Examiner Kamand Cuneo at (703) 308-1233. Examiner Cuneo's supervisor is Examiner Jeffrey Gaffin whose telephone number is (703) 308-3301.

K. Cuneo

Patent Examiner Group 2841

September 25, 2000

estisa: Patent Etaminer Sandray Canter 2800

5